

REMARKS

In the Office Action¹, the Examiner rejected claims 43, 46, 48-51, 54, and 56-59 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Application Publication No. 2005/0278771 to Hassell et al. ("Hassell") in view of U.S. Patent No. 6,588,015 to Eyer et al. ("Eyer"); rejected claims 44 and 52 under 35 U.S.C. § 103(a) as unpatentable over *Hassell* in view of *Eyer* and further in view of U.S. Patent No. 6,807,367 to Durlach ("Durlach"); rejected claims 45 and 53 under 35 U.S.C. § 103(a) as unpatentable over *Hassell* in view of *Eyer* and further in view of U.S. Patent Application Publication No. 2003/0088872 to Maissel et al. ("Maissel"); and rejected claims 47 and 55 under 35 U.S.C. § 103(a) as unpatentable over *Hassell* in view of *Eyer* and further in view of U.S. Patent No. 6,323,911 to Schein et al. ("Schein").

By this Amendment, Applicants amend claims 43, 44, 47, 51, 52, 55, and 59, and add new claims 74-88.

I. The Rejection of Claims 43, 46, 48-51, 54, and 56-58 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 43, 46, 48-51, 54, and 56-58 as allegedly unpatentable over *Hassell* in view of *Eyer*.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

explicit and cannot be premised upon mere conclusory statements. See id. “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” M.P.E.P. § 2145. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1996) . . . The factual inquires . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III). In this application, a *prima facie* case of obviousness has not been established because the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Office Action has failed to clearly

articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Independent claim 1 recites an apparatus comprising, among other things, “selection means for skipping over the first content item to the second content item or selecting a position within the first content item based on a duration of the user input” and “display means for displaying an indicator of a current replaying position.”

Hassell and *Eyer*, taken alone or in combination, fails to render obvious the claimed display means. The Examiner concedes that “*Hassell* combined with *Eyer* ... do not explicitly teach a display showing the current position of the video being displayed” (Office Action at p. 8). Therefore, *Hassell* and *Eyer*, taken alone or in combination, fail to teach or suggest the claimed “display means for displaying an indicator of a current replaying position.”

As explained above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, no reason has been clearly articulated as to why the claim would have been obvious to one of ordinary skill in view of *Hassell* and *Eyer*. Therefore, a *prima facie* case of obviousness has not been established for independent claim 1 for at least this reason. Although of different scope than claim 1, independent claim 51 is distinguishable from *Hassell* and *Eyer* for at least the same reasons as claim 1.

Claims 45 and 48-50 depend from claim 1, and claims 54 and 56-58 depend from claim 51. Because *Hassell* and *Eyer* do not support the rejection of independent claims

1 and 51 under 35 U.S.C. § 103(a), *Hassell* and *Eyer* also do not support the rejection of dependent claims 45, 48-50, 54, and 56-58.

II. The Rejection of Claims 44 and 52 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 44 and 52 under 35 U.S.C. § 103(a). Claim 44 depends from claim 43, and claim 52 depends from claim 51. As already discussed, *Hassell* and *Eyer* fails to render obvious the claimed display means.

Durlach fails to cure the deficiencies of *Hassell* and *Eyer*. *Durlach* discloses a viewing method for progressing through a movie sequence using a dial (*Durlach*, abstract). *Durlach* also discloses that the movie advances more slowly or more quickly depending on how quickly a user rotates a dial, and a “current location indicator 206” that indicates where the user has advanced to within the movie (*Durlach*, col. 13, lines 1-18 and FIG. S4). However, *Durlach* does not disclose both a first and second content item, as *Durlach*’s movie simply constitutes a single content item. Therefore, *Durlach*’s “current location indicator” cannot correspond to the claimed “current replaying position” as the claimed “current replaying position” is part of an apparatus that allows skipping over content items. In short, *Durlach*’s display means does not allow for displaying replaying positions in a first and a second content item. Therefore, *Durlach* fails to render obvious a “display means for displaying an indicator of a current replaying position,” as recited by independent claim 43.

Applicants provide further remarks regarding the proposed combination of *Durlach* with *Eyer*. *Eyer* discloses a digital broadcast system that provides interactive features such as skip forward and skip backward (*Eyer*, abstract), where a user can

play a current track or skip to subsequent or earlier tracks (*Eyer*, abstract). However, even if *Durlach*'s display means is combined with *Eyer*'s broadcast system, the claimed combination falls short because *Durlach*'s current location indicator is constrained to a single content item.

In contrast, to the proposed combination of *Durlach* and *Eyer*, the claimed system allows a user to learn how to use the selection means by viewing the indicator on the display means. Because the display means displays the indicator of the current replaying position, the user can simply view the display means to ascertain whether an input has resulted in skipping over the first content item or selecting a position within the first content item. Neither *Durlach* nor *Eyer* solves this problem, because *Eyer* does not disclose an indicator of a current replaying position and *Durlach*'s indicator only indicates a position within a single content item.

As explained above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, no reason has been clearly articulated as to why the claim would have been obvious to one of ordinary skill in view of *Hassell*, *Eyer*, and *Durlach*. Therefore, no *prima facie* case of obviousness has been established with respect to claims 44 and 52. Applicant therefore respectfully requests the Examiner to withdraw the rejection of these claims under 35 U.S.C. § 103(a).

Dependent claim 44 is further distinguishable from *Hassell*, *Eyer*, and *Durlach*. Claim 44 recites "wherein the display means displays the indicator at the beginning of the second content item when the user skips over the first content item" (emphasis

added). As discussed, *Durlach* discloses a current location indicator 206. However, *Durlach* does not disclose any facility for skipping over a content item, and therefore *Durlach* simply fails to disclose any actions taken with respect to current location indicator 206 upon skipping over a content item. Therefore, claim 44 is allowable over *Hassell*, *Eyer*, and *Durlach*. Claim 52 recites similar subject matter to claim 44, and is allowable for similar reasons.

III. The Rejection of Claims 45 and 53 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 45 and 53 under 35 U.S.C. § 103(a). Claim 45 depends from claim 43, and claim 53 depends from claim 51. As already discussed, *Hassell* and *Eyer* fail to render obvious the claimed display means.

MaisSEL fails to cure the deficiencies of *Hassell* and *Eyer*. *MaisSEL* discloses, “[i]n a digital television recording method, programs are selected for recording based on analysis of program schedule information, user preferences, and the priority of previously recorded programs” (*MaisSEL*, abstract). *MaisSEL* also discloses a “NEXT” button that can be used to browse forward through the stored programs (*MaisSEL*, ¶ 368). However, *MaisSEL* does not disclose a current replaying position that operates in an apparatus that allows skipping over content items. Therefore, *MaisSEL* does not render obvious a “display means for displaying an indicator of a current replaying position,” as recited by independent claim 1.

As explained above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, no reason has been clearly articulated

as to why the claim would have been obvious to one of ordinary skill in view of *Hassell*, *Eyer*, and *Maisel*. Therefore, no *prima facie* case of obviousness has been established with respect to claims 45 and 53. Applicant therefore respectfully requests the Examiner to withdraw the rejection of these claims under 35 U.S.C. § 103(a).

IV. The Rejection of claims 47 and 55 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 47 and 55 under 35 U.S.C. § 103(a). Claim 47 depends from claim 43, and claim 55 depends from claim 51. As already discussed, *Hassell* and *Eyer* fails to render obvious the claimed selection means.

Schein fails to cure the deficiencies of *Hassell* and *Eyer*. *Schein* discloses a “television schedule system and method” using an “input device [that] allows the viewer to browse through the schedule information area” (*Schein*, abstract). *Schein* also discloses a “local controller” with a “horizontal scroll mechanism for moving the cursor in an ‘x’ direction or horizontally across the display screen ... buttons 32, 34 can be configured so that continuous depression of one button 32, 34 moves the cursor horizontally through a plurality of items” (*Schein*, col. 5, lines 45-59). However, even assuming *Schein*’s “items” correspond to the claimed first and second content items, *Schein* does not disclose the claimed indicator of a current replaying position. Therefore, *Schein* does not render obvious a “display means for displaying an indicator of a current replaying position,” as recited by independent claim 43.

As explained above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the

claimed invention and the prior art. Accordingly, no reason has been clearly articulated as to why the claim would have been obvious to one of ordinary skill in view of *Hassel*/*Eyer*, and *Schein*. Therefore, no *prima facie* case of obviousness has been established with respect to claims 47 and 55. Applicant therefore respectfully requests the Examiner to withdraw the rejection of these claims under 35 U.S.C. § 103(a).

V. Conclusion

In view of the foregoing, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 10, 2008

By: /David W. Hill/
David W. Hill
Reg. No. 28,220